



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,394	03/07/2002	Atsushi Yokouchi	Q68888	9620

7590 02/28/2003

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, NW
Washington, DC 20037-3213

EXAMINER

JOHNSON, JERRY D

ART UNIT

PAPER NUMBER

1764

DATE MAILED: 02/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/091,394

Applicant(s)

YOKOUCHI ET AL.

Examiner

Jerry D. Johnson

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/254,172.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____.

Art Unit: 1764

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naka et al. in view of Heimann et al.

On page 1 of the specification, under the heading Technical Field, applicants disclose

This invention relates to a rolling bearing and particularly a rolling bearing which is used under such a condition that water may seep in the lubricant or the bearing is affected by high temperature, high-speed rotation or vibrations and is suitable to electric parts and accessories of an automobile engine such as an alternator. (Emphasis added).

Column 1, lines 5-20 of Naka et al., U.S. Patent 5,728,659, teach

The present invention relates to a grease composition for rolling bearings. More particularly, it relates to a grease composition employed for rolling bearings in electrical components and accessory devices for automotive vehicles, such as alternators, electromagnetic clutches for car air conditions, idle pulleys, electric fan motors, or the like. (Emphasis added).

Naka et al., U.S. Patent 5,728,659, teach a grease composition for a rolling bearing comprising 10 to 60 parts by weight of a mixture of diurea compounds as a thickener based on 100 parts by weight of a base oil (column 2, lines 13-44). The base oil used in the grease is not particularly limited, and any oil used as a base oil for a lubricating oil may be used (column 5, lines 9-11). Base oils having a kinematic viscosity of preferably 40 to 400 mm²/s, more preferably 60 to 250 mm²/s, most preferably 80 to 150 mm²/s at 40°C is preferred (column 5, lines 11-18). The grease composition may optionally contain publicly known additives in order to further improve

its properties (column 7, lines 31-33). These additives may be used alone or as a combination of two or more kinds. The amount of the additives to be added is no particularly limited, but usually not more than 20% by weight of the grease composition (column 7, lines 42-47). Naka et al. differ from the instant claims in not teaching the addition of a pH adjustor.

Heimann et al., U.S. Patent 6,010,984, teach lubricant and grease compositions which imparts corrosion and microbial resistance, and a high dropping point (column 2, lines 12-15). The pH of the grease can be tailored to be compatible with the metal surface which is contacted with the grease or gel (column 5, lines 59-60). The grease will typically have a pH that ranges from about 7 to about 14 (column 6, lines 2-3). The addition of conventional additives is taught in column 8, lines 5+.

A person having ordinary skill in the art, armed with the disclosure of Heimann et al., would have found it obvious to add a pH adjustor to the grease composition of Naka et al. in order to adjust the pH to "about 7 to about 14" and tailor the grease to be compatible with the metal surface which is contacted with the grease with a reasonable expectation of enhancing the corrosion resistance of said composition.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is rendered indefinite by the recitation "or a derivative thereof."

This is a continuation of applicant's earlier Application No. 09/254,172. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry D. Johnson whose telephone number is (703) 308-2515. The examiner can normally be reached on 6:00-3:30, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Caldarola can be reached on (703) 308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5408 for regular communications and (703) 305-3599 for After Final communications.

Art Unit: 1764

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read "Jerry D. Johnson". The signature is fluid and cursive, with the first name "Jerry" and last name "Johnson" clearly distinguishable.

Jerry D. Johnson
Primary Examiner
Art Unit 1764

JDJ
February 27, 2003